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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,637	06/02/2000	KALEVI AHOLA	027566-016	7880
27045 7590 04/16/2007 ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			EXAMINER BORLINGHAUS, JASON M	
			ART UNIT	PAPER NUMBER
			3693	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/509,637

Applicant(s)

AHOLA, KALEVI

Examiner

Jason M. Borlinghaus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites conditional language without sufficiently providing one of ordinary skill instructions for proceeding in the event at least one of the conditions fails. Such Claim is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Furthermore, the Claim is extremely broad as it is silent regarding what will be done if the condition fails, hence giving the claims their broadest reasonable interpretation; a reasonable alternative is to do nothing. Note also that this rationale applies to subsequent dependent claims that depend from this initial conditional statement, and/or contain a conditional limitation as language.

Appropriate correction is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 21 - 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett (US Patent 5,991,748) in view of Official Notice.

Regarding Claims 21 - 27, Taskett discloses a method of paying for calls and services paying for calls and services in a telecommunications network (service provider network), that comprises a charging controller (host computer), the charging controller including a user account database (account database) having user accounts (user data records) that are used by the charging controller to apply prepaid charges and various user services charges (decreases account balance), the method comprising the steps of the user (see abstract; col. 5, lines 18 – 31; col. 7, lines 30 – 65):

- purchasing a voucher or cash instrument (prepaid transaction card) associated with an amount in a voucher record in a voucher database (prepaid account balance stored in host computer). (see col. 3, lines 47 – 50);

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- the voucher or cash instrument (prepaid transaction card) having an identifier (identification number) and a secret code (other information necessary for transferring funds from card). (see col. 6, lines 17 – 36);
- utilizing the identifier and the secret code to access the voucher record in the voucher database. (see col. 6, lines 17 – 36; col. 7, lines 30 – 44); and
- transferring a specified amount (selected amount) from the voucher record (data record) in the voucher database (host computer) to a user account in the user account database, wherein the charging controller is adapted for applying user charges to the user account in the user account database (account balance is updated to reflect fund transfer). (see col. 7, lines 30 – 44);
- wherein the voucher (transaction card) record in the voucher database comprises a first field for the identifier of the voucher or cash instrument (identification number of transaction card), a second field for the secret code (other information necessary for transferring funds from card), and a third field for the amount (account balance) of the voucher. (see col. 3, lines 37 – 61; col. 6, lines 17 – 35);
- wherein utilizing a loading service (host computer) for transferring all or part of the amount of the voucher (transaction card) from the voucher record in the voucher database to a monetary field (account balance) in a user record in the user account database (account database, wherein the user record

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comprises a plurality of files including a user identifier field (account code) and the monetary field (account balance); (see col. 6, line 58 – col. 7, line 44);

- wherein the amount of the voucher in the voucher record in the voucher database is used only for transferring money to the monetary field in the user record in the user account database. (see col. 6, line 58 – col. 7, line 44);

Taskett does not explicitly teach wherein the identifier and secret code is independent of any association with the user; a fourth field for blocking the voucher; nor a block transferring a specific amount from the voucher record.

However, Examiner takes **Official Notice** that identifiers and other identifying information associated with an anonymous prepaid transaction voucher, such as a prepaid gift card or a gift certificate, relate to the voucher itself and not to the card's anonymous user, which is old and well known in the art of finance and payment methods.

Examiner also takes **Official Notice** that the creating a computer record for blocking a voucher, such as flagging a stolen voucher or a possibly fraudulent transaction, and blocking a transfer over specific amount, such as when a transfer would be in excessive of a card's remaining value or credit limit, is old and well known in the art of finance and payment methods.

It would have been obvious to one of ordinary skill at the invention was made to have modified Taskett to incorporate such methodologies and/or mechanisms, as are old and well known in the art, as such methodologies and/or mechanisms are standard and conventional in the art.

Regarding Claims 28 - 34, Taskett discloses a method comprising:

- purchasing a voucher or cash instrument (prepaid transaction card) associated with an amount (prepaid account balance) stored in a voucher record in a voucher database (host computer), the voucher or cash instrument (transaction card) having a identifier (identification number). (see col. 3, lines 47 – 60; col. 4, lines 35 – 50);
- a user initiating a prepaid call to a called party. (see col. 1, lines 21 – 39);
- the network routing the call to a prepaid service (host system that manages remote accounts). (see col. 1, lines 21 – 39);
- identifying the caller (via predetermined authorization number). (see col. 1, lines 21 – 39);
- determining the balance (account balance) in a prepaid account (remote account) associated with the user in a user account database (host system). (see col. 1, lines 21 – 39);
- wherein the network connects the caller to the called party. (see col. 1, lines 21 – 39); and
- if the prepaid account (account balance) is empty, notifying (warning/prompting) the caller to load an additional amount to the prepaid account (account balance) associated with the user. (see col. 7, line 45 – col. 8, line 18);
- whereupon the user connects to a loading (regeneration) service of the network. (see col. 7, line 45 – col. 8, line 18);

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- the user providing the identifier (credit card number) for accessing the voucher funds. (see col. 1, lines 46 – 53); and
- wherein all or part of the amount in the voucher funds is then sent (withdrawn and deposited) via the loading service (host system) to the prepaid user account. (see col. 1, lines 46 – 53);
- wherein the voucher (transaction card) record in the voucher database comprises a first field for the identifier of the voucher or cash instrument (identification number of transaction card), a second field for the secret code (other information necessary for transferring funds from card), and a third field for the amount (account balance) of the voucher. (see col. 3, lines 37 – 61; col. 6, lines 17 – 35);
- transferring (transferring) all or part of the amount of the voucher or cash instrument (prepaid account balance of prepaid transaction card) in the third field of the record in the voucher database (host computer) to a monetary field (account balance) in the user record (telephone card record) in the user account database (host system). (see col. 3, lines 46 – 54; col. 5, lines 35 – 40; see col. 7, lines 30 – 44);
- wherein the user record comprises a plurality of fields including a user identification field (authorization code) and the monetary field (current balance). (see col. 6, lines 17 – 35); and

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- wherein the amount of the voucher in the voucher record in the voucher database is used only for transferring money to the monetary field in the user record in the user account database. (see col. 6, line 58 – col. 7, line 44).

Taskett does not teach a method utilizing an intelligent network, service switching points nor service control points; wherein the identifier and secret code are independent of any association with the user; a fourth field for blocking the voucher or cash instrument; a personal identification number field; nor a block transferring a specific amount from the voucher record.

However, Examiner takes **Official Notice** that utilizing an intelligent network, service switching points and service control points in a telecommunication system is old and well known in the art of telecommunication systems.

Examiner takes **Official Notice** that identifiers and other identifying information associated with an anonymous prepaid transaction voucher, such as a prepaid gift card or a gift certificate, relate to the voucher itself and not to the card's anonymous user, which is old and well known in the art of finance and payment methods.

Examiner also takes **Official Notice** that the creating a computer record for blocking a voucher, such as flagging a stolen voucher or a possibly fraudulent transaction, and blocking a transfer over specific amount, such as when a transfer would be in excessive of a card's remaining value or credit limit, is old and well known in the art of finance and payment methods.

It would have been obvious to one of ordinary skill at the invention was made to have modified Taskett to incorporate such methodologies and/or mechanisms, as are

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old and well known in the art, as such methodologies and/or mechanisms are standard and conventional in the art.

Regarding Claim 35, Taskett does not teach that the user account database records and the voucher database records are combined into one database.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined records from two databases into one database, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); *In re Larson, Russler & Meldahl*, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965).

Regarding Claims 36 - 41, such claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection. Due to deficiencies in the prior office action mailed on 10/11/07, Examiner has re-written his prior office action. Although the same prior art is utilized, Examiner hopes that better mapping of the prior art to the

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claim language and clearer articulation of his rejection will address applicant's prior expressed concerns.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 4/10/07
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